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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,716	06/10/2005	Toshiya Fujisato	AKA-0286	6913
23599 7590 05/09/2008 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER				
KAUSHAL, SUMESH				
ART UNIT		PAPER NUMBER		
1633				
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05/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,716

Applicant(s)

FUJISATO ET AL.

Examiner

Sumesh Kaushal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/20/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 4.5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4.5 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's response filed on 02/20/08 has been acknowledged and fully considered.

Claims 4-5, 7-9 and 10-11 are pending and are examined in this office action.

Applicants are required to follow Amendment Practice under revised 37 CFR §1.121. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300**. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/20/08 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-5, 7-9 and 10-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claim as amended recites new claim limitation "until essentially no residual cell nuclei are observed on microscopic examination of the tissue. The applicant states that the support for the amendments is found at least in spec. para. 24 and fig -2. However a careful review by the examiner of the specification failed to identify any support for this new limitation. Since no basis has been found to support the new claim limitation in the specification, the claims are rejected as incorporating new matter. As MPEP 2163.06 notes "If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. In re Rasmussen , 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5, 7-9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Login et al (US 4994237, 1991).

The instant claims are drawn to method for exposing a mammalian tissue to microwave irradiation in a solution while maintaining the temperature between 0°C to 40°C.

Login et al teaches a method to prepare biological tissues (e.g. heart valves, veins, cartilage, ligaments) and organs for use as bioprostheses, and more particularly, it relates to a rapid method to preserve tissue samples with a solution, to irradiate samples in a microwave oven (*Note: standard microwave oven operates at 2.45 GHz see Boon et al EP0362438A1, 1990*), and to store samples in a storage medium (see

Fig-1, Spec. col.1, lines 12-20. also Col. 8-10 i.e. claims). The cited art further teaches that microwave irradiation in conjunction with a physiologic salt solution or a dilute aldehyde solution, leads to a degree of preservation such that tissue flexibility is promoted and collagen cross-linking is minimized. The cited art further teaches that the object of the present invention is to preserve biologic tissue for implantation into animals or humans such that the bioprosthesis will function physiologically (i.e. resist mechanical failure under physiologic conditions). In order to achieve this goal, microwave energy is used to irradiate the tissue (see Spec. col.5, lines 60-). The cited art further teaches that the tissue is immersed in an osmotically balanced solution (OBS, see table-1) and then irradiated in a microwave oven until the OBS reaches a temperature within the range of 35°C to 50°C. The cited art further teaches that after the microwave irradiation, the tissue is transferred and stored in a cold sterile saline solution (see Spec. col. 3, lines 53-68). The cited art further teaches that the broadest aspects of the invention involve removing the tissue from its blood supply, immersing the tissue in an osmotically balanced solution (OBS) initially at room temperature (approximately 20°C), irradiating the immersed tissue with microwave energy at a sufficient dose and for a sufficient time such that the temperature of the solution is within the range of 35°C. to 50°C, and storing the tissue in a sterile OBS until it is implanted in a patient (see spec col.4, lines 35-45).

The cited art further teaches a comparison study using pig heart valves, wherein the valve leaflets were rinsed in standard electrolyte solution and fixed using three different treatment methods: (a) immersion in a 0.6% glutaraldehyde solution for 24 hours at 25°C. (b) immersion in an aldehyde OBS at 22°C and exposure to microwave irradiation for 11 seconds to reach a final solution temperature of 47°C and (c) immersion in an aldehyde OBS at 22°C. wherein irradiation exposure time was limited to 8 seconds at which time the solution reached a final temperature of 40°C. The cited art teaches that the microwave treated samples were removed from the warm solution within thirty seconds and were stored in 0.9% saline at 4°C with 0.02% sodium azide (see col.6, line 20-).

In addition, if the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In instant case the cited art clearly anticipate the invention as claimed because the composition and functions as claimed are presumed inherent. The composition is physically the same it must have the same properties. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In *re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) see MPEP § 2112.02. In the instant case Login et al clearly teaches that the immersed tissue are irradiated with microwave energy at a sufficient dose and for a sufficient time such that the temperature of the solution is within the range of 35°C to 50°C, which would lead to decellularization as claimed (see spec col.4, lines 35-45). Thus given the broadest reasonable interpretation the cited art clearly anticipates the invention as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Login et al (US 4994237, 1991) as applied to claims 4-5, 7-9 and 10 above, and further in view of Giberson et al (US 6875583, 2005) and Boon et al (EP0362438A1, 1990).

The teaching of Login et al (US 4994237, 1991) has been described above. Even though Login et al teaches a method to preparing tissue using microwave treatment while maintaining the temperature between 0°C to 40°C, the cited art does not that the temperature is maintained via heat-exchange contact with a coolant liquid received in a microwave-transmitting vessel, and wherein said tissue is irradiated with microwaves in a microwave oven (at 2450 MHz) from 1 hour to 1 week, while circulating said coolant liquid through a cooling apparatus provided externally of the microwave oven.

Giberson et al (US 6875583, 2005) teaches microwave-treatment of fresh tissue, comprising immersing the tissue in a solution comprising a detergent and heating the immersed tissue using a microwave at a temperature of 4°C to 40°C by pumping the fixation solution through a cooling apparatus which is outside of the microwave oven for 1 hour. Giberson further teaches that the thickest tissues require approximately 60 min of microwave treatment (see fig-1, col. 5, lines 62-67, col. 10-12).

Boon et al (EP0362438A, 1990) teaches microwave treatment of xenogeneic cartilage transplants using standard microwave device that operates at 2.45 GHz. Thus it would have been obvious to one ordinary skilled in the art at the time the instant invention was made to modify the invention of Login et al with Giberson et al by incorporating a heat exchange device that can maintain temperature in the range of 0-40°C using a standard microwave device that operates at 2.45 GHz as taught by Boon et al. One would have been motivated to do so to control tissue overheating during microwave treatment. One would have a reasonable expectation of success, since use of microwave irradiation (*using standard microwave ovens that operate at 2.45 GHz*) to

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treat tissue sample of choice has been routine in the art at time the instant invention was made. Thus the invention as claimed is prima facie obvious in view of cited prior art of record.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal whose telephone number is 571-272-0769. The examiner can normally be reached on Mon-Fri. from 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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